



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

STEINS & ASSOCIATES
2333 CAMINO DEL RIO SOUTH
SUITE 120
SAN DIEGO CA 92108

MAILED

SEP 29 2011

Patent No. 6,149,165 : **OFFICE OF PETITIONS**
Tuan Nguyen :
Issue Date: November 21, 2000:
Application No. 09/104,852 : DECISION ON PETITION
Filed: June 25, 1998 :
Attorney Docket No. NGU1-A94A :

This is in response to the PETITION FOR PETITION FOR RECONSIDERATION OF PETITION FOR REINSTATEMENT OF PATENT EXPIRED UNINTENTIONALLY UNDER 37 CFR 1.378(b) filed June 21, 2011, which is properly treated pursuant to 37 CFR 1.378(e) as a request for reconsideration of decision on petition under 37 CFR 1.378(c).

BACKGROUND

The patent issued November 21, 2000. The window for paying the first maintenance fee extended from November 21, 2003 through May 21, 2004 without surcharge, and from May 22, 2004 through November 21, 2004 with surcharge. A Notice of Patent Expiration for failure to pay the first maintenance fee was mailed on December 22, 2004.

With respect to the 3 ½ year maintenance fee, an initial petition was filed on May 25, 2005. Patentee argued that the maintenance fee and late surcharge were timely filed on May 27, 2004. In support thereof, patentee submitted copies of their certificate of facsimile transmission and their facsimile activity report. However, patentee did not submit a complete copy of the 5 page maintenance fee payment as they maintain it was originally filed on May 27, 2004. Accordingly, by decision mailed June 30, 2005, the petition was dismissed. The decision requested a copy of the complete facsimile transmission.

Patentee did not respond to the decision. No further action was taken by patentee within 24 months of the expiration date of the patent. On January 9, 2006, the Office refunded the maintenance fee and surcharge (as is practice when a patent is not reinstated).

The window for paying the second maintenance fee (if this patent were not expired) would have extended from November 21, 2007 through May 21, 2008 without surcharge, and from May 22, 2008 through November 21, 2008 with surcharge. With respect to the 7 ½ year maintenance fee, on June 17, 2010, patentee filed a petition asserting that the entire delay in paying the second maintenance fee was unintentional. In addition, patentee asserted that the decision with respect to the first maintenance fee had never been received. (As such, the petition did not include a response to the first decision).

By decision mailed April 20, 2011, the petition was dismissed. Given that the petition with respect to the first maintenance fee was not granted and the fees on petition refunded, the instant petition was not filed within twenty-four months after the actual expiration of the six-month grace period at midnight on November 21, 2004¹. In order for the petition under 37 CFR 1.378(c)² with respect to the second maintenance fee to be granted, patentee was required i) to submit evidence to meet the Delgar standard for establishing non-receipt of an Office action, ii) to explain their actions as to inquiring regarding the status of the petition, iii) to respond to the initial decision and provide a showing that the first maintenance fee was timely paid and iv) to repay the refunded fees and other fees due for reinstatement.

OPINION

On instant renewed petition, the petition includes a showing to the satisfaction of the Director that the decision mailed June 30, 2005 was never received (including the individual patent and master docketing reports per *Delgar* where the decision would have been entered had it been received). Further, under the

¹ The prior decision contained a typographical error in referring to this date as January 22, 2004.

² Otherwise, patentee was advised that he could only obtain reinstatement of this patent via the provisions of 37 CFR 1.378(b), by showing that the entire delay in paying the maintenance fees was unavoidable.

circumstances of the initial expiration, considering the showing on the initial petition which was promptly filed and patentee's explanation of their discovery of non-receipt, the delay in discovering the non-receipt of the petition decision and consequently, in acting on the decision is excused.

In addition, patentee submitted the required \$400 surcharge, \$490 for the 3 $\frac{1}{2}$ year maintenance fee, \$1240 for the 7 $\frac{1}{2}$ year maintenance fee, and \$1,640 for the surcharge for unintentional delay).

On the merits with respect to the first maintenance fee, the renewed petition includes the Credit Card Payment Form, as patentee maintains it was originally filed on May 27, 2004.³ The Credit Card authorization form shows that on May 27, 2004, the first maintenance fee and late surcharge in this patent in the amount of \$520 (\$455 for maintenance fee and \$65 for surcharge) were authorized. The initial petition included a certificate of facsimile transmission dated May 27, 2004 along with the facsimile confirmation report showing a successful facsimile transmission on May 27, 2004. Further, patentee explained on renewed petition that the other 2 pages of the facsimile were the Credit Card Payment Form and Maintenance Fee payment for another patent with fees due on that date (see p. 2/3 of renewed petition filed June 21, 2011).

The renewed petition under 1.377 to accept and record the first maintenance fee as timely paid is granted.

On the merits with respect to the second maintenance fee, the petition filed on June 17, 2010, was filed within twenty-four months after the expiration of the six-month grace period for paying the second maintenance fee on November 21, 2008. As required, petitioner submitted with the petition the required maintenance fee, the surcharge for accepting an unintentionally delayed maintenance fee after expiration, and a statement that the delay in payment of the maintenance fee was unintentional.

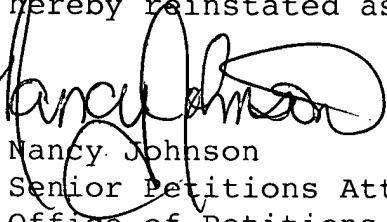
The request for reconsideration of petition under 1.378(e) to accept the unintentionally delayed payment of the second maintenance fee is granted.

³ Patentee states that the renewed petition includes the other two pages of the facsimile, the Certificate of Facsimile and Credit Card Payment Form, as originally filed on May 27, 2004. However, the renewed petition actually only includes the Credit Card Payment Form.

CONCLUSION

The first maintenance fee and surcharge after grace period are accepted and made of record as timely filed on May 27, 2004

Payment of the second maintenance fee has been shown to have been unintentionally delayed. The second maintenance fee in this case is hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions